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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,358	05/17/2002	Maria Davis	PB-9944	9975

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GE HEALTHCARE BIO-SCIENCES CORP.
PATENT DEPARTMENT
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EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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06/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/049,358	Applicant(s) DAVIS ET AL.	
	Examiner Richard G. Hutson	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15,23-26 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/12/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants preliminary amendment of claims 15 and 21-28 and the cancellation of claims 1-14 and 16-20, in the paper of 4/12/2007, is acknowledged. Claims 15 and 21-28 are still at issue and are present for examination.

Claims 21-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicants request to rejoin the method claims 21-25 is acknowledged and is found persuasive to rejoin the claims 23-25. Claims 21-22 are not found subject to rejoinder for the following reasons.

Claims 23-25 as amended share the special technical feature of the allowable product of claim 15 and have thus been rejoined with the product of claim 15, while claims 21-22 do not share the special technical feature of claim 15, because claims 21 and 22 as newly amended are drawn to a method of sequencing DNA comprising the step of generating chain terminated fragments from the DNA template to be sequenced with the DNA polymerase of Claim 15. Thus while claims 21 and 22 depend from claim 15, these claims are drawn to a method of sequencing DNA comprising the step of generating chain terminated fragments from the DNA template "to be sequenced by the DNA polymerase of claim 15". This reference to the DNA polymerase of claim 15, is an intended use of the DNA fragments generated from the DNA template. Claims 21 and 22 are not drawn to a use of the allowable product claim. Thus claims 21 and 22 are not subject to rejoinder as they do not share a special technical feature with the allowable product claim.

Information Disclosure Statement

Applicants filing of information disclosure statement, filed on 4/12/2007, is acknowledged. Those references considered have been initialed.

Specification

The disclosure is objected to because of the following informalities:

Applicant's specification contains 19 Figures, of which Figures 1-3 and Figures 6-13 each contain what appears to be amino acid or nucleic acid sequences, however, there is not a corresponding sequence identifier for each of these sequences.

Applicants attention is directed to: **M.P.E.P. 2422.02** The Requirement for Exclusive Conformance; Sequences Presented in Drawing Figures, which states:

" when a sequence is presented in a drawing, regardless of the format or the manner of presentation of that sequence in the drawing, the sequence must still be included in the Sequence Listing and the sequence identifier ("SEQ ID NO:X") must be used, either in the drawing or in the Brief Description of the Drawings."

Appropriate correction is required.

Allowable Subject Matter

Claims 15 and 23-26 are allowable over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard G Hutson, Ph.D.
Primary Examiner
Art Unit 1652